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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,655	11/12/1999	BRIAN D. MORRISON	1843	1910

7590 12/03/2003

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/03/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

clp 20

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/439,655	MORRISON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Judy M. Reddick	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## Office Action Summary

Application No.

09/439,655

Applicant(s)

MORRISON ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

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- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-11 and 13 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

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a) ☐ All b) ☐ Some \* c) ☐ None of:  
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**DETAILED ACTION**

**Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 14, 2003 has been entered.

**Claim Objections**

2. Claim 8 is objected to because of the following informalities: In claim 8 @ line 4, "of at about" should read "of about" and @ line 5, ""dg/min" should be inserted after "1,000". Appropriate correction is required.

**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-11 and 13 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kosaka et al(U.S. 3,944,695, as applied to claims 1, 4-9 and 11) or Liedermooy et al(U. S. 5,500,472, as applied to claims 1, 4-11 and 13) as

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per reasons stated in the previous Office Action per paper no. 12, 02/12/03, paragraph no. 8. Further, as to claims 1, 10 & 13, Kosaka et al teach 10 to 60 wt.% of at least one tackifier selected from the group consisting of terpene resins, phenol resins, etc.(the Abstract, which clearly meets the limitations per claim 1 b)) and Liedermooy et al teach 25 to 55 wt.% of a terpene phenolic tackifying resin or a hydrogenated derivative thereof(clearly meeting the limitations per claims 1 b), 10 and 13); Even if it turns out that the claims are not anticipated by Kosaka et al or Liedermooy et al, it would have been obvious to the skilled artisan to extrapolate the precisely defined hot-melt adhesive composition, as claimed, from each of Kosaka et al and Liedermooy et al as per such having been within the purview of the general disclosures of each of Kosaka et al and Liedermooy et al and with a reasonable expectation of success.

#### Response to Arguments

6. Applicant's arguments filed 11/14/03 have been fully considered but they are not persuasive.

Relative to Kosaka et al---As to the melt index of the ethylene-vinyl acetate copolymer, Counsel's argument is not deemed persuasive because whether the presence is optional or not, preferred or not, its presence is still disclosed. The disclosure of a composition of matter in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it is unsatisfactory for the intended purpose. In re Nehrenberg 126 USPQ 383. Similarly, all disclosures of the prior art, including unpreferred or auxiliary embodiments, must be considered in determining obviousness. In re Mills, 176 USPQ 196; In re Lamberti, 192 USPQ 278; In re Boe, 148 USPQ 507.

A reference is available for all that it teaches, including disclosures that teach away from invention as well as disclosures that point toward invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 296 (Fed. Cir. 1985).

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Relative to Liedermooy et al----As to the terpene phenolic tackifier and ethylene-vinyl acetate copolymer in terms of copolymer content and vinyl acetate content, Counsel is cordially directed to the Abstract, the paragraph bridging cols. 1-2, col. 2, lines 52-61, Table I and the claims.

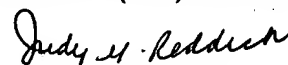
7. Applicant's arguments, see paper no. 19, filed 11/14/03, with respect to the rejections under 35 USC 102(b)/103(a) over Mehaffy et al and Bodouroglou et al, have been fully considered and are persuasive. The rejections have been withdrawn.


#### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR   
11.26.03